

USSN: 09/09/747,537  
Atty. Docket No.: 10212/2  
Response dated November 11, 2003  
Reply to Final OA of September 17, 2003

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### REMARKS

The indication in paragraph 1 of the Office Action that the Advisory Action of May 5, 2003 was withdrawn is noted and appreciated.

Claims 1-7, 9, 10, 12-30, 33, 35, 37, and 38 are pending. All claims were rejected in the Office Action under numerous applications of 35 U.S.C. Sections 112 and 103. Each of the rejections will be addressed below in the order presented in the Office Action.

#### Rejections Under 35 U.S.C. Section 112

Paragraphs 2 and 3 of the Office Action reject claims 37 and 38 under Section 112 as failing to comply with the written description requirement. Specifically, the Office Action asserts that the recited shrinkage values are inaccurate.

The limitations set forth in the claims are to the "sum" of the film's machine direction and transverse direction shrinkages at 135°C. The claim limitation is not to the "area" of the shrinkage as the claims are interpreted in the Office Action. For this reason alone, it is submitted that claims 37 and 38 are compliant with Section 112 since they simply recite the "sum" of the two shrinkage values set forth in the Examples of the Application.

Moreover, the calculation of the surface area reduction through shrinkage set forth in the Office Action is not understood. In the Example discussed, machine direction shrinkage is 7% and transverse direction shrinkage is 10.7%. The Office Action calculates an area of reduction of 23.5%. It is unclear how this calculation was made. When calculating area reduction due to shrinkage, the following equation may be used:

$$\% \text{ Area Reduction} = 100\% - \frac{(100 - \text{machine direction shrinkage})(100 - \text{transverse direction shrinkage})}{100}$$

In the Example discussed, the equation calculates an area reduction of 17%, not 23.5%.

Reconsideration of the Section 112 rejection is respectfully requested based upon the fact that claims 37 and 38 clearly recite the "sum" of the machine direction and transverse direction shrinkages.

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### **Previous Rejections**

Paragraphs 4-8 of the Office Action notify of withdrawal of previous rejections under 35 U.S.C. Sections 102 and 103 in response to arguments and claim amendments submitted in the previous Response. These withdrawals are noted and appreciated.

### **Rejections Under 35 U.S.C. Section 103**

Claims 1-7, 9, 10, 12-18, and 30 are rejected in paragraphs 9 and 10 of the Office Action under 35 U.S.C. Section 103 as being unpatentable over U.S. Patent 5,234,733 to Shloegl in view of U.S. Patent 5,108,844 to Blemberg.

These rejections concede that Shloegl does not teach that the core layer of his films should include a polymeric modifier. The cornerstone of these rejections is that it would be obvious to include a polymeric modifier in Shloegl's core layer because Blemberg teaches that a first film layer may incorporate a polymeric component of an adjacent second film layer to promote adhesion between the two layers. Therefore, the Office Action contends that it would be obvious to blend one of the polymeric components of the skin layers of Shloegl into the core layer to promote adhesion between the core and skin layers.

It is respectfully submitted that it would not be obvious to include one of the skin layer components of Shloegl in the core layer. The focus of Blemberg is to improve adhesion between polyolefin layers and layers of other materials including vinylidene chloride copolymers, polyesters, polyamides and/or polycarbonates of the cast films. See column 1, lines 27-29 and column 2, lines 32-35. Blemberg makes it clear that adhesion problems between layers of these particular types of films are known to exist. Blemberg proposes to solve the adhesion problem by blending 10-30% of the non-polyolefin material of the skin layer into the polyolefin core layer. In contrast, Shloegl relates to films wherein the core layer is a polyolefin material (column 3, lines 12-16) and the adjacent sealing layers are also polyolefin materials (column 3, lines 35-60). Therefore, the teachings and suggestions of Blemberg are simply not applicable to the Shloegl reference. Moreover, Shloegl reveals no adhesion problems between layers nor would one expect adhesion problems in his films because of the similarities of the adjacent layer materials.

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It is well established that there must be some teaching or suggestion to combine two references in a Section 103 rejection. The requisite teaching or suggestion is absent in the applied reference combination. One skilled in the art would not be motivated to apply the teachings of Blemberg to Shloegl because there is no reason to do so because of the lack need for Shloegl's benefits.

Paragraphs 11 and 12 of the Office Action reject claims 1-7, 9, 10, 12-18, 29, and 30 over Shloegl in view of U.S. Patent 5,691,043 to Keller. This rejection is founded upon the conclusion that it would be obvious to provide a modifier in the core layer of Shloegl in view of a teaching to include a modifier in the core layer of Keller's film structures.

It is respectfully submitted there is no motivation to look to the teachings of Keller to modify Shloegl. While there are other distinctions between the two references, there are fundamental distinctions that preclude looking to Keller to modify Shloegl. Keller relates to oriented films shrinkable in only one direction. Column 3, lines 39-49 disclose that the Keller films have a transverse shrinkage of 1% or less while exhibiting machine direction shrinkage of at least 25%. In contrast, Shloegl relates to films with "extraordinarily high shrinkability" in the transverse direction with "extraordinarily low shrinkability" in the machine direction. In particular, the films exhibit shrinkage of greater than 35% in the transverse direction and less than 6% in the machine direction. See, column 4, lines 52-62. Therefore, the characteristics of the films of the references are fundamentally different and, in fact, they are opposites. One would not look to the teachings of Keller to provide modifications for the films of Shloegl.

Keller's films are produced by what is referred to as a secondary orientation process. In this process, the film is stretched first in the machine and transverse directions. Thereafter, the film is cooled and then stretched again in the machine direction. See column 9 for a detailed discussion of the process. According to Keller's teachings, the **secondary orientation** step prompts the film to tear. One of Keller's contributions is to include a polyolefin modifier in the core layer of the film to prevent tearing during the secondary orientation step. See column 4, line 42 through line 10 of column 5.

Thus, the modifier is added to the core layer for the express purpose of reducing the film's tendency to tear during the second orientation step. Keller provides no teaching or

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suggestion that the modifier is useful in the primary orientation step. Since Shloegl does not include a secondary orientation step, one would not look to Keller's teachings to suggest including a modifier in Shloegl's core. For this reason alone, it is respectfully submitted that the Shloegl and Keller references, neither alone nor in combination, render the claimed inventions obvious.

In paragraphs 13 and 14 of the Office Action, claims 1-7, 9, 10, 12-28, 30, 33, 35, 37, and 38 were rejected under Section 103 as being obvious over U.S. Patent 5, 372,882 to Peiffer in view of Blemberg. This rejection is similar to the above-discussed Shloegl in view of Blemberg combination. The rejections acknowledge that Peiffer fails to disclose a polymeric modifier in its core layer. However the rejections conclude that it would be obvious to include a modifier in the core layer of Peiffer since Blemberg teaches inclusion of a component from one layer in an adjacent layer to promote adhesion between the two layers.

However, as discussed above with respect to the Shloegl and Blemberg combination, Peiffer's core layer includes polyolefinic materials as does Peiffer's outer layer. Therefore, since both layers contain polyolefinic materials, there is no motivation, as suggested by Blemberg, to blend one component of the outer layer into the core layer of Peiffer.

Additionally, Peiffer discloses no adhesion problems between film layers. Therefore, there is no motivation to look to Blemberg to remedy adhesion problem which is the focus of Blemberg.

For these reasons, it is respectfully submitted that the Peiffer and Blemberg combination fails to render the claimed inventions obvious.

Paragraphs 15 and 16 of the Office Action reject claims 1-7, 9, 10, 12-30, 33, 35, 37, and 38 as being obvious over Peiffer in view of Keller. As discussed with respect to the Shloegl and Keller combination above, like Shloegl, Peiffer discloses a biaxially shrinkable film. One would not look to Keller which teaches production of uniaxially shrinkable films for guidance to include a modifier in the core layer.

More importantly, as with Shloegl, Peiffer does not use the secondary orientation process that Keller advises results in film tearing. As discussed above, Keller teaches inclusion of a modifier in the core layer for the express purpose of preventing tearing during the secondary

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orientation process without mention of any benefit manifested in the primary orientation process. Therefore, one would not look to Keller for the suggestion to include a modifier in the core layer of Peiffer since the reasons for doing so are absent in Peiffer's films.

For these reasons, it is respectfully submitted that the Peiffer and Keller combination is deficient in rendering the claimed inventions obvious.

#### **Response to Previous Arguments**

The following is Applicant's response to the comments on page 15 of the Office Action. It was stated with respect to the teachings of Blemberg, it is unnecessary that a primary reference recognize adhesion as a problem to be solved by Blemberg's teachings. It is respectfully submitted that there must be some teaching or motivation to combine the teachings of the secondary reference with the primary reference. Blemberg teaches there is an adhesion problem between layers of categorically different materials. For this reason alone, one would not expect adhesion problems between adjacent layers in the primary references because the materials of these layers are not categorically different. In the absence of a suggestion in the primary references, the burden is not on the Applicant to prove that there is no adhesion problem.

Without a suggestion that there is a need to promote better adhesion between adjacent layers in the primary references, one would not be motivated to use the teachings of Blemberg to solve a nonexistent problem. Moreover, one would not be motivated to add different materials to the core layer of a film just in case there might be some problem solved by the addition. Finding motivation under these circumstances is tantamount to concluding it would be obvious to include every conceivable component found in any film layer in another film layer, regardless of the benefits of such inclusion. The law is well settled, there must be some teaching or suggestion to make the combination. The teaching or suggestion is absent in the combinations of Blemberg and the primary references.

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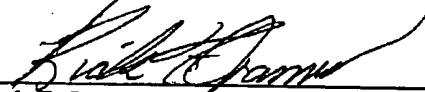
**Conclusion**

Consistent with the foregoing, claims 1-7, 9, 10, 12-30, 33, 35, 37, and 38 are believed to be in condition for allowance. Reconsideration of these claims with an early Notice of Allowance is respectfully submitted.

It is believed that this submission is fully responsive to the outstanding Office Action. However, should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number listed below so that all matters may be expeditiously resolved.

Respectfully submitted,

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